IN THE

Supreme Court of the United States

OCTOBER TERM, 1963

No. 3052

THE DUCTLESS HOOD CO., INC., NEW MILFORD CONSTRUCTION AND REPAIR COMPANY and GEORGE A. SCHARMER,

Petitioners,

A & B HOME APPLIANCES, INC.,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

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No. .....

THE DUCTLESS HOOD CO., INC., NEW MILFORD CONSTRUCTION AND REPAIR COMPANY and GEORGE A. SCHARMEL,

Petitioners,

vs.

A & B HOME APPLIANCES, INC.,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

Petitioners prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Second Circuit, entered in the above-entitled case on May 14, 1963.

Citations to Opinions Below

The Opinion of the Court of Appeals for the Second Circuit is reported at 317 F. 2d 696 (1963) and is printed in Appendix A hereto, *infra*, page 12. The Opinion of the District Court is reported at 210 F. Supp. 57 (1962), and is printed in Appendix C, *infra*, page 14.

Jurisdiction

The judgment of the Court of Appeals was entered on May 14, 1963 (p. 13, *infra*). The jurisdiction of this Court is invoked under 28 U. S. C., Section 1254(1).

Questions Presented

1. In the determination of what the patentee is to receive in return for the disclosure made in a patent grant, is the expertise of the Patent Office to be overruled by the courts where no more pertinent prior art is before them than was before the Patent Office (in this case the only pertinent prior art, the prior Sonntag patent 2,369,375, was considered and rejected by the Patent Office), in particular, in a case such as this where the record demonstrated and the courts recognized that the public received a novel, important and practical device of striking popularity?

2. Did the courts below err in holding that the Scharmer patent lacked invention over the prior impractical, never used, Sonntag patent on the basis that relocation of air outlets from the top to the front of a kitchen exhaust hood was obvious when the record demonstrated a long industry-wide need for the patented device and a widespread, immediate, phenomenal acceptance and slavish imitation by the industry of the patented device, i.e., that it was this step which turned failure into success, an impractical device into a practical one?

Statutes Involved

The pertinent portions of the statutes involved are:

1. Section 282 of the Patent Act of July 19, 1952, 66 Stat. 792, 35 U. S. C. Sec. 282:

> "A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it. . . ."

2. Section 103 of the Patent Act of July 19, 1952, 66 Stat. 792, 35 U. S. C. Sec. 103:

> "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which such subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

Statement of the Case

Petitioners sued respondent A & B Home Appliances, Inc. for patent infringement in the United States District Court for the Eastern District of New York, invoking jurisdiction under 28 U. S. C. 1338.

The patent in suit is Scharnier patent 2,886,124 (P. App.[1] 101a), issued May 12, 1959, relating to a ductless recirculating kitchen range hood for installation above a kitchen range to control by-products of cooking, e.g., grease, smoke, odors, emanating from the range. The hood recirculates air from the range to the kitchen after filtering and purification as distinguished from prior ventilating or ducted hoods discharging air to the outside through a duct and prior non-ventilating or blank hoods which served primarily to collect some of the grease. The device essentially comprises a hood with a flat top and air discharge openings

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[1] The record as printed for the use of the court below consists of Plaintiffs-Appellants' Appendix (P. App. ——) and Defendant-Appellee's Appendix (D. App. ——). This appendix record is filed for consideration by this Court as Volume I, Appendix for Plaintiffs-Appellants and Volume II, Appendix for Defendant-Appellee. Volume II also contains the proceedings in the Circuit Court of Appeals.

in the downwardly sloping or forwardly and downwardly projecting front wall of the hood in combination with air purifying means mounted in the hood, including filters, motor and blower wheels (see Fig. 10 of the patent). The device is characterized by ease and cheapness of installation under a kitchen storage cabinet; it can be installed where it is impossible or prohibitively costly to duct to the outdoors or where it is desired to save valuable kitchen cabinet space. The device was the first ductless recirculating kitchen range hood (P. App. 20a, 29a, 32a).

The events culminating in this petition began with the development by Scharmer, an independent inventor with very limited resources, of his novel recirculating hood and the display of a model at a builder's show in Chicago in 1956. To meet the demand resulting from its enthusiastic reception at the show, Scharmer and his very small company, New Milford Construction and Repair Company, assigned the patent rights to the Ductless Hood Company, Inc., a small Manhasset, N. Y. company formed for the purpose of manufacturing and selling the novel device. In 1957, the device was introduced under the trademark "Ductless Hood". The device, the first recirculating non-ducting hood to be marketed, was readily and widely accepted by the public. By 1962 the yearly sales of recirculating non-ducting hoods, including the Ductless Hood and hoods copied from it and the Scharmer patent, had reached the 200,000 to 250,000 unit level ($10,000,000 to $15,000,000 per year) (Finding of Fact No. 12, P. App. 11a, 27a).

In 1959, Major Industries, Inc., a Pennsylvania Company organized by a former distributor of Ductless Hood, entered the field with the infringing device, the Nautilus No-Duct Hood. Now there are over twenty manufacturers of recirculating non-ducting hoods copied from the Ductless Hood and the Scharmer patent (Finding of Fact No. 13, P. App. 11a, 22a-24a), three of which are licensees of Ductless. Major kitchen equipment companies such as

Nutone, Phillip-Carey, Robbins and Meyers are among the imitators.

In May 1959, petitioners brought this patent infringement action against respondent, A & B Home Appliances, Inc., a Brooklyn, N. Y. dealer in or distributor of the infringing device. Major Industries, Inc. assumed the defense of the action. Respondent admitted infringement and advanced only the defense of invalidity. After trial, the District Court held that the patent was invalid for lack of invention over the prior patent to Sonntag (P. App. 102a), a patent considered and rejected by the Patent Office (P. App. 97a-100a), and judgment was entered dismissing the complaint. On appeal, the Court of Appeals accepted the findings of the District Court and affirmed on its opinion.

The District Court stated in its Opinion, *infra*, page 14, that the Scharmer device was novel, "a desideratum in the modern kitchen", "the practical advantages of Scharmer's device and its commercial priority are not to be disparaged" and "this variant's popularity is striking" and yet held the device to be obvious in view of the impractical, never used device of the prior Sonntag patent, fully considered and rejected as a reference by the Patent Office.

REASONS FOR GRANTING THE WRIT

I. The decisions of the courts below overruling the Patent Office and ignoring the statutory presumption of validity present an important question of public policy under the patent laws and moreover are in conflict with a basic principle of patent law established by decisions of other Courts of Appeals.

The decisions of the courts below presents an important question of public policy. The Patent Office experts considered and rejected the Sonntag patent and decided that the Scharmer device was inventive and patentable, that

the public would receive a novel and useful device which would further the progress of the useful arts in return for the monopoly granted. The Patent Office was proved to be correct. The courts below recognized the novelty and utility and practical advantages and striking popularity of the device. The record demonstrates that the public received a novel and useful device. Businesses were created because of the device, its success has been phenomenal, it is imitated widely. To say now that the device was not inventive over the impractical, never used, device of the prior patent to Sountag, on a record of admitted infringement, which record demonstrates widespread, immediate acceptance and slavish imitation and exposes no facets bearing on the question of invention leading to doubt as to the correctness of the Patent Office decision, subverts the patent laws. It can only give rise to a popular impression that an inventor is the lawful prey of infringers. The courts below clearly exceeded the appropriate scope of judicial review of a Patent Office determination and certiorari should be granted to determine the appropriate scope of review.

The courts below ignored the principle that the presumption of validity is strengthened where the most pertinent prior art was considered by the Patent Office and an infringer seeking to overcome the statutory presumption of validity must produce prior art which is *more pertinent* than the prior art considered by the Patent Office. See *Williams Mfg. Co. v. United Shoe Mach. Corp.*, 121 F. 2d 273 (6th Cir. 1941), affirmed 316 U. S. 364, wherein it was stated at page 277:

> "To the presumption of validity that attaches to a granted patent, where the most pertinent prior art has been cited against it in the patent office, there must probably now be added the force of a growing recognition of finality that is generally being accorded to administrative determinations supported by evidence, on the ground that the administrative agency is expected to have developed an expertness in its

"specific field beyond what may be expected from the courts wherein adjudications range the whole field of human controversies."

See also *University of Illinois Foundation* v. *Block Drug Co.*, 241 F. 2d 6, 10-11 (7th Cir. 1957), *cert. den.* 354 U. S. 922. See also *Power Curbers, Inc.* v. *E. D. Etnyre & Co.*, 298 F. 2d 484 (4th Cir. 1962), wherein it was stated at page 493:

"The fact that the defendants were unable to come up with any prior art more pertinent than the McIntyre patent strengthens the presumption of the validity of the patent in suit."

Of the prior art advanced by defendant, the courts below rejected all except Sonntag and found that only the Sonntag patent was pertinent; the opinions mention no other prior art. The Sonntag patent was carefully considered by the Patent Office.

The courts below also ignored the principle that the presumption is strengthened by objective evidence of the filling of a long felt need for the device, the long availability of elements needed to achieve the invention, its phenomenal commercial success and widespread imitation. Such objective evidence was demonstrated in this case and, indeed, recognized by the courts below. As was stated at page 157 in *U. S. Pipe and Foundry Co.* v. *James B. Clow & Sons, Inc.*, 205 F. Supp. 140 (N. D. Ala. 1962), affirmed as to invention 313 F. 2d 46, 51 (5th Cir. 1963):

"[12] The presumption of validity in this case has been strengthened as stated above by this invention filling a longfelt need in the industry and its immediate commercial use and success when it was placed on the market by plaintiff."

To the same effect see *Harris et al.* v. *National Machine Works*, 171 F. 2d 85 (10th Cir. 1948); *cert. den.* 336 U. S. 905.

The correct application of the presumption of validity, arising from the expert knowledge of the Patent Office, is of increasing importance in the decision of patent cases and certiorari should be granted to resolve the present conflict.

The case represents an opportunity to reflect the intention of the Congress, expressed in the patent laws to assist "the individual inventor working in a field in which he has technical competence and directing his efforts toward the current problems in that field, performs a vital and important function. The patent system is designed to encourage this type of inventor" (Review of the American Patent System, Report No. 1464 of the Senate Committee on the Judiciary, 84th Congress, 2nd Session, January 30, 1956, p. 2). The holdings below can only favor the entrenched and discourage the individual inventor, the lone innovator, the garret worker, and further monopoly by large industry. Any decision by a district or circuit court which states "The mistake of the Patent Office—" with no facts not available to that organization and directly challenging the correctness of its appraisal, is subject to serious question.

2. The courts below employed a test of invention in conflict with principles established by decisions of this Court and other Courts of Appeals.

The basis for the decisions of the courts below that the Scharmer patent lacked invention over the prior Sonntag patent was that relocation of air outlets from the top, as shown in Sonntag, to the front of a kitchen exhaust hood was obvious. This use of hindsight is a discredited subjective basis which ignores the objective evidence of record and belittles the question because of the apparent simplicity of the relocation, the apparent small departure. It is in conflict with decisions of this Court establishing the principle that small departures from former means

making the difference between an impractical machine and a practical device cannot be used to detract from invention and the principle that objective evidence of filling a long need, availability of elements needed to achieve the device, acceptance of the device and widespread imitation is to be used as a test of invention rather than subtle conjecture and hindsight. As stated in *Computing Scale Co.* v. *Automatic Scale Co.*, 304 U. S. 669, at page 616:

> "It is true that many valuable inventions seem simple when accomplished, and yet are entitled to protection. *The books abound in cases showing inventions involving only small departure from former means, yet making the difference between a defective mechanism and a practical method of accomplishing results.* In such cases a decision in favor of invention as distinguished from mere mechanical improvement has not infrequently resulted, in view of the fact that the device has *made the difference between an impracticable machine and a useful improvement* displacing others theretofore occupying the field." (Emphasis supplied.)

See also *Diamond Rubber Co.* v. *Consolidated Tire Co.*, 220 U. S. 428, wherein the court stated at page 435:

> "Knowledge after the event is always easy and problems once solved present no difficulties, indeed, may be represented as never having had any, and expert witnesses may be brought forward to show that the new thing which seemed to have eluded the search of the world was always ready at hand and easy to be seen by a merely skillful attention. But the law has other tests of the invention than subtle conjectures of what might have been seen and yet was not. *It regards a change as evidence of novelty, the acceptance and utility of change as a further evidence, even as demonstration.*" (Emphasis supplied.)

In *Goodyear Co.* v. *Ray-O-Vac*, 321 U. S. 275, the invention consisted of encasing a standard dry cell flashlight battery in a can to protect the flashlight casing from leakage from the battery, a defect that was known. The court stated at page 279:

> "Viewed after the event, the means Anthony adopted seem simple and such as should have been obvious to those who worked in the field, but this is not enough to negative invention. During a period of half a century, in which the use of flashlight batteries increased enormously, and the manufacturers of flashlight cells were conscious of the defects in them, no one devised a method of curing such defects. Once the method was discovered it commended itself to the public as evidenced by marked commercial success."

The decision is also in conflict with these principles as established by other Courts of Appeals. See *U. S. Pipe and Foundry Co. v. James B. Clow & Sons, Inc.*, 205 F. Supp. 140, 157 (N. D. Ala. 1962), affirmed as to invention 313 F. 2d 46, 51 (5th Cir. 1963) and *Mott Corp.* v. *Sunflower Industries*, 314 F. 2d 872, 879 (10th Cir. 1963).

The record establishes that there was a long industry-wide need for the device since the 1930's (P. App. 20a-22a, 31a-34a; Finding of Fact No. 12, P. App. 11a), that the elements needed to achieve the invention were long available, and that the device was recognized as a practical, novel solution to an old problem. It met with phenomenal commercial success. Scharmer's device was the first re-circulating hood and all competing devices are copied from it, not from Sonntag. It is widely imitated. Scharmer's relocation was the final step that turned a failure into a success. *The Barbed Wire Patent*, 143 U. S. 275, 283.

Certiorari should be granted to review the test of invention applied by the courts below and resolve the conflict.

Conclusion

For the foregoing reasons, this petition for a writ of certiorari should be granted.

Respectfully submitted,

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Appendix A

Opinion of the Court Below

PER CURIAM:

In an action for infringement of U. S. Patent 2,886,124, for a "kitchen conditioner," issued to George A. Scharmer on May 12, 1959, the district court sustained the defense of lack of invention over the prior art, specifically the Sonntag patent (U. S. Patent 2,369,375), and dismissed the complaints. The advancement claimed by the plaintiffs for their "invention" is the relocation of air outlets from the top to the front of a kitchen exhaust hood. If the top of the hood is to be covered by cabinets—the situation for which plaintiffs' product was designed—the obvious answer is moving the louvres. This hardly shows invention. Thus we accept the findings of District Judge Dooling and affirm on his persuasive opinion, D. C. E. D. N. Y., 210 F. Supp. 55.

Affirmed.

Appendix B

Judgment of the Court Below

UNITED STATES COURT OF APPEALS

FOR THE

SECOND CIRCUIT

At a Stated Term of the United States Court of Appeals, in and for the Second Circuit, held at the United States Courthouse in the City of New York, on the fourteenth day of May one thousand nine hundred and sixty-three.

Present: Hon. CHARLES E. CLARK,
Hon. J. JOSEPH SMITH,
Hon. PAUL R. HAYS,
Circuit Judges.

DUCTLESS HOOD COMPANY, INC., NEW MILFORD CONSTRUCTION & REPAIR COMPANY, GEORGE A. SCHARMER,

Plaintiffs-Appellants,

v.

A AND B HOME APPLIANCES, INC.,

Defendant-Appellee.

Appeal from the United States District Court for the Eastern District of New York.

This cause came on to be heard on the transcript of record from the United States District Court for the Eastern District of New York, and was argued by counsel.

ON CONSIDERATION WHEREOF, it is now hereby ordered, adjudged, and decreed that the judgment of said District Court be and it hereby is affirmed with costs to the appellee.

A. DANIEL FUSARO,
Clerk.

Appendix C

District Court Opinion

DOOLING, D. J.:

Plaintiff, Scharmer devised and in 1959 was granted a patent (No. 2,886,124) on a hood for kitchen ranges that had installed inside it a grease filter, deodorizer, suction unit and ductwork so arranged that the stovetop gases could be sucked in, purged of grease and odors and then recirculated to the kitchen through the louvred front of the hood, all without any connection to the outdoors. In external appearance Scharmer's hood looked like other powered range hoods, save that its downwardly sloping front or visor was louvred so as to serve as the outlet for the purged air to be recirculated. In make-up Scharmer's hood differed from the usual powered kitchen range exhaust hood in the significant respect that it required no costly built-in duct work connecting to the outdoors, since it purified the air within the hood and returned it to the kitchen; it was on this account much cheaper and easier to install; even more importantly, it could be installed where it was impossible or prohibitively costly to make a connection to the outdoors. The top of Scharmer's hood is flat and is, very expressly, not used as an exhaust or outlet path.

The practical advantages of Scharmer's device and its commercial priority are not to be disparaged. As so often, the question is whether Scharmer's device was already in the public domain when he confected it. Scharmer's hood, complete in all the sub-elements of its identity, did not exist before Scharmer; if it was in the public domain it was so in the sense that nothing beyond the application to existing articles and methods of the common skills commonly employed was necessary to bring the device into being. In the latter sense, it is concluded, Scharmer's ductless hood was already extant in the public domain when he gave it tangible exemplification.

District Court Opinion.

The hood and the aspects in which it claims patentable novelty are simply described. The hood, designed for installation over a cookstove top, includes (i) an opening through which the stove-top gases collected under the hood will be drawn; (ii) a flat rectangular grease filter (*e.g.*, the familiar "metal wool" filter) so located that the gases drawn through the opening have to traverse it and deposit their grease, (iii) a deodorizer (such as a canister, or flat rectangular, type of activated carbon air-purifier) through which the gases will be drawn, (iv) a motor and fan (or wheel or blower assembly) to create negative pressure under the hood strong enough to suck the gases into the hood opening, through the filter and purifier over the motor and then send them along, and (v) an outlet to the kitchen. So much Scharmer's hood includes and it shares each of these elements and their union with the prior art—and these elements are the operative ones. That is, Scharmer did not devise a method for purifying and recirculating kitchen air. Scharmer did not bring primary elements (old or new) to the makeup of the operative combination of elements. And Scharmer did not introduce a new method of combining the primary elements of this known combination or impose on them any new primary rule of action.

What Scharmer claims as peculiarly his is that combination of these operators in which the entire hood assembly is flat topped and thus adapted for installation under a kitchen cabinet—a desideratum in the modern kitchen that emphasizes efficiency of arrangement and elimination of waste motion—and in which the front or visor of the hood is louvred so that the front of the hood may be the purified-air outlet.

The prior art did not disclose this variant of the combination of primary operators and this variant's popularity is striking. Was it patentable invention or a common mechanical response to a product requisition? It seems the

latter. It is not invention but its refutation to produce, in response to a service request an article every element of which is embodied in the terms of the request—and that is so even if no such product was ever before requested, where, at the least, the request is for a product for a described and evident service. The extant (on paper) device of Sonntag (U. S. Patent No. 2,369,375) presented the primary operators of the combination (the ozonizer *vice* activated carbon purifier being, for present purposes, an immaterial difference in an element present for an identical function). His difference from Scharmer was that Sonntag's preferred (and illustrated) embodiment of his device emitted the purified air through screened openings in the top. Sonntag's location of the openings in the top of his device was not a *point* of structure that Sonntag was making: he does not mention, though he illustrates, their precise location but rather describes them by their function of returning the air to the kitchen (No. 2,369,375, p. 2, col. 2, lines 10-11, 16-17, 70-72) and not by their location: Sonntag's claims—as it happens—are not all limited to orifices in the top of his device (see, *e.g.*, claims 1, 2 and 8). Not Sonntag's invention, but Sonntag's illustration of the preferred embodiment of his invention had the exit passages, immaterially, in the top rather than the sides or front or back of his baffle chamber or purifying chamber. That is not to say that Sonntag suggested or illustrated louvres in the front wall or visor of the hood. He did not. But, he went far enough so that any competent workman, asked for a Sonntag unit to attach to the underside of a kitchen cabinet, would have produced Scharmer without more ado. The request, the bare, unsuggestive empty request, stated in terms of the service desired, not in terms of a means to perform it, automatically would produce the alleged invention: it is the most obvious way to meet the service request; it is the identical obviousness that makes us walk through doorways rather than the adjacent walls.

In the prosecution of the patent, Sonntag was not cited until after the first interview and after the third office action and after the examiner had found that various of the then pending claims had been drawn to patentable subject matter and that certain then pending claims were allowable. Sonntag and others were bravely distinguished by saying, "Vezey, Gaylord, Gay and Sonntag all pass the air upwardly through the top. It is an entirely new concept to discharge the air from a tubular housing beneath the top of the hood, e.g., from the ends of the housing as in Fig. 2 or from the upper portion of the front wall [i.e., the louvre in the visor] thereof as in Figs. 7, 8, 9, 10 and 11. The new concept and the recited means for embodying it defined in claim 3 make it possible to mount the hood directly under a kitchen cabinet, which is impossible with these references, as well as all the other cited art . . . All of the references except Sonntag No. 2,369,375 give the air only an upward movement. Sonntag gives it first an upward, then a horizontal and then another upward movement, . . . These structural and functional differences distinguish patentably over Sonntag and the other patents . . . The top wall is defined as imperforate. These features are not found in any of the references including Sonntag No. 2,369,375." (Ex. 14, pp. 42, 43, 44, see also p. 54, discussion of claim 27.) Claims, later allowed, were at the same time re-written expressly to incorporate the "below the top" idea by which Sonntag was distinguished—including what had been Claim 3 and is Claim 1 as allowed—notwithstanding that Claim 3 as originally applied for specified "a flat top adapted to be secured directly under a kitchen cabinet", a structure dictating front, side, rear or bottom emission but not, as the claim was drawn, claiming the range of the structure as a patentably novel advance on top emission, which was not, strictly, contemplated by the claim though admitted by it. Further amendment followed a further interview—includ-

ing a refinement of claim language to distinguish emission "below" the top from emission "beneath" the top (*i.e.*, the side emission in lateral stream of Fig. 3 was thought of as "beneath the top since still within the limits of the hood and the emission through the visor, as in Fig. 10, was considered "below" the top of the hood though outside of it) (Ex. 14, p. 53). Sonntag 2,369,375 was again, inferentially, distinguished (in discussing the degree to which the "top" would be "imperforate") in this language: "The important feature is not whether the top wall is imperforate or not but whether the air discharge opening is in the top wall, as in Sonntag 2,369,375 and other patents, which would prevent the locating of such a hood directly under a kitchen cabinet, or in a free wall beyond the plane of the front of the cabinet, such as the front wall . . . . of the presently illustrated embodiments of the invention." (Ex. 14, p. 53). The claims of the patent were then allowed.

The mistake of the Patent Office lay in its acceptance of a useful difference in structure as an unobvious advance without, at the critical stage in the prosecution, reconsidering the applicability of the standard of Section 103, as had been done earlier and before the relevancy of Sonntag 2,369,375 was perceived. The resulting mistake was that of accepting a difference in arrangement as invention when it was, from the point of view of patentable novelty, a bare choice in arrangement and not a new devising of arrangements. The obviousness of the union of sub-elements relied on for patentable novelty deprives the patent of validity.

Brooklyn, New York, September 27, 1962.

JOHN F. DOOLING,
U. S. D. J.